

REMARKS

By this amendment, claims 1 and 14 have been amended, and claim 12 has been cancelled without prejudice. Claims 1-11 and 13-14 are thus currently under examination in the present application. For the reasons set forth below, Applicants submit that the present amendments and arguments place this application in condition for immediate allowance.

As an initial matter, Applicants respectfully submit that the present amendments to claims 1 and 14 are proper and should be entered as these amendments do not raise issues requiring further consideration or present limitations which would require more than a cursory review, based on the previously presented claims. In particular, claims 1 and 4 have been amended to clarify that the recited plasticizer and the recited pore-forming substance are distinct from one another, and to affirmatively recite, in step d) of claims 1 and 14, a requirement regarding the formation of pores. As indicated, for example, on page 4 of the application the calcining step d) is utilized to remove the pore-forming substances added in step a) and to thereby increase the porosity of the catalyst. As such, it was previously inherent in claims 1 and 14 that the calcining step d) was used to form pores. Furthermore, by the present amendments to claims 1 and 14, these claims have been amended to incorporate the limitation previously presented in claim 12 regarding the amount of pore-forming substance added to the mixture of step a). Accordingly, Applicants submit no undue burden is created by the present amendments and that the amendments should be entered.

In the Office Action dated November 19, 2008, the Examiner rejected claims 1-3, 5-7, and 9-14 under 35 U.S.C. §103(a) as being unpatentable over Grosch, et al. (DE 19623611) in view of Sepulveda, et al. (U.S. 4,613,427). The Examiner also rejected claims 4 and 8 under 35 U.S.C. §103(a) as being unpatentable over Grosch in view of Sepulveda and further in view of Balducci, et al. (U.S. 5,965,476). In making the rejections, the Examiner asserted that the claims of the present application would have been obvious because the substitution of one known pore-forming substance for another (i.e. the melamine of Sepulveda for the methyl cellulose of Grosch) would have yielded the predictable results of obtaining an optimum pore volume. For the reasons set forth below, Applicants respectfully traverse the Examiner's rejections and request that they be withdrawn.

As discussed above, by the present amendments, claims 1 and 14 have been amended to clarify that the recited plasticizer and the pore-forming substance are distinct from one another; to affirmatively recite, in step d), a requirement regarding the formation of pores; and, to further indicate that the pore-forming substance is added to the mixture of step a) in an amount of from 6-14% by weight. This specific amount of pore-forming material is not taught or suggested by the cited Grosch reference. Grosch merely describes a process for the preparation of epoxides from olefins and hydrogen peroxide by using an epoxidation catalyst, and the composition described in the Grosch reference comprises no more than 2% by weight of methylcellulose.

Furthermore, it is also the case that Grosch does not teach or suggest the creation of a pore in a catalyst material, as specified in claims 1 and 14 of the present application.

Indeed, nowhere in the disclosure of Grosch is there any teaching or suggestion that pores are, or should be formed, in the described epoxide material. Grosch describes the use of methylcellulose as a plasticizer to assist in the shaping of the catalyst during the extrusion process, however, this description regarding the use of a methylcellulose as a plasticizer does not teach or suggest the formation of pores. The formation of pores is an event that is distinct from the plasticization of a material and there is no apparent reason, nor has the Examiner provided one, why one of ordinary skill in the art would equate a plasticization process with the formation of pores.

In this regard, Applicants thus submit that there is no reason for a person of ordinary skill in the art to combine the teachings of Grosch and Sepulveda in a manner that would produce the claimed invention. Although, Sepulveda relates to the formation of a solid catalyst from a natural clay that makes use of a pore-forming substance to produce an optimum pore volume in the final catalyst, a decision to use this teaching from Sepulveda in conjunction with the disclosure of Grosch would mean that a person of ordinary skill in the art would have already understood that pore formation would be beneficial or advantageous in the preparation of epoxides. However, this teaching regarding the formation of pores in the preparation of epoxides is completely missing from the references cited by the Examiner. As such, there fails to be any reason why one of ordinary skill in the art would seek to optimize the formation of pores in a catalyst when such a teaching has not been disclosed in the prior art. Only using impermissible hindsight, using the present disclosure as a blueprint, would there be any suggestion or motivation for optimizing the formation of pores in the preparation of epoxides.

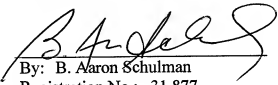
Accordingly, Applicants respectfully submit that the present invention is not rendered obvious by the cited references and that the claims of the present application are clearly patentable over those references. Applicants thus submit that the Examiner's rejection on the basis of those references is respectfully traversed and should be withdrawn.

In the Office Action, the Examiner further rejected claims 1-14 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,699,812 in view of the Grosch, *et al.* reference. Without addressing the merits of this rejection, Applicants are submitting herewith a terminal disclaimer under 37 C.F.R. §1.321(c). As such, Applicants respectfully submit that the double patenting rejection has become moot and should be withdrawn.

In light of the amendments and arguments provided herewith, Applicants submit that the present application overcomes all prior rejections and objections, and has been placed in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

Date: February 17, 2009


By: B. Aaron Schulman
Registration No.: 31,877

STITES & HARBISON PLLC ♦ 1199 North Fairfax St ♦ Suite 900 ♦ Alexandria, VA 22314
TEL: 703-739-4900 ♦ FAX: 703-739-9577 ♦ CUSTOMER NO. 000881